

REMARKS

Claims 1 through 14 are pending in the case.

Examiner has rejected claims 1 through 14.

Response to new Arguments made by Examiner

Examiner has argued as follows:

In response to Applicant's argument that Meister fails to teach the use of a field of the email message used to specify addresses to be removed from the 'To' field, the Examiner respectfully disagrees. Meister has been shown to teach a control that allows a user to select addresses to be removed by the e-mail system before the sending of the message. The Examiner contends that this control is part of the e-mail message as it allows the user to send the message by way of the "OK" button 44 of Fig. 2, and further edit the message by way of a message modification control as described at col. 3, lines 51-56. Therefore, the Examiner maintains the rejection of the claims over Meister.

Examiner's discussion of Meister ignores the language of the claims of the present case. For example, claim 1 includes the following language: "a field of the e-mail message used to specify addresses to be removed by the electronic mail system from a 'To' field." Thus the language of claim 1 specifically requires a *field* of the e-mail message be used to specify addresses to be removed from a "To" field.

Examiner has made no attempt to show that an e-mail message shown by Meister includes such a *field*. Rather, Meister only discloses a *control* which allows a user to manually remove addresses from a "To" field of an e-mail message. See Meister at Figure 6 and column 5, lines 17 through 27.

As discussed below: "[a] claim is anticipated only if each and every element as set forth in the claim is found, either expressly or inherently described, in a single prior art reference." *Verdegaal Bros. v. Union Oil Co. of California*, 814 F.2d 628, 631, 2 USPQ2d 1051, 1053 (Fed. Cir. 1987). "The identical invention must be shown in as complete detail as is contained in the ... claim." *Richardson v. Suzuki Motor Co.*, 868 F.2d 1226, 1236, 9 USPQ2d 1913, 1920 (Fed. Cir. 1989).

Any person of ordinary skill in the art would recognize that the *control* disclosed by Meister is not a *field* of an e-mail message, as set it in claim 1 of the present case. Therefore, it is clear that the claims of the present case are not anticipated by Meister.

Rejection under 35 U.S.C. § 102 (e)

Examiner has rejected claims 1 through 14 under 35 U.S.C. § 102 (e) as being anticipated by USPN 6,671,718 (Meister). Applicant respectfully traverses the rejection and requests reconsideration.

Criteria for a Rejection under 35 U.S.C. § 102

The criteria for a rejection under 35 U.S.C. § 102 has been clearly defined by the courts and confirmed by the U.S. Patent and Trademark Office. "A claim is anticipated only if each and every element as set forth in the claim is found, either expressly or inherently described, in a single prior art reference." *Verdegaal Bros. v. Union Oil Co. of California*, 814 F.2d 628, 631, 2 USPQ2d 1051, 1053

(Fed. Cir. 1987). "The identical invention must be shown in as complete detail as is contained in the ... claim." *Richardson v. Suzuki Motor Co.*, 868 F.2d 1226, 1236, 9 USPQ2d 1913, 1920 (Fed. Cir. 1989).

Examiner has failed to show that each and every element set forth in the claims is found either expressly or inherently in Meister. Based on this, Applicant is traversing the rejections of the claims.

Below, Applicant points out subject matter within each independent claim that is not disclosed by Meister. On the basis of this, Applicant believes all the claims are patentable over Meister.

Independent Claim 1

Claim 1 sets out a method by which an electronic mail system sends an electronic message. Step (a) sets out that the electronic mail system, in preparation for sending an e-mail message, checks a field of the e-mail message used to specify addresses to be removed by the electronic mail system from a "To" field. The electronic system removes from any addresses specified in the "To" field of the e-mail message any addresses within the field of the e-mail message used to specify addresses to be removed from the "To" field. This is not disclosed or suggested by Meister.

Meister allows a user to manually remove addresses from a "To" field of an e-mail message. See Meister at Figure 6 and column 5, lines 17 through 27. However, Meister does not disclose or suggest the use of a field of the e-mail message used to specify addresses to be removed from the "To" field.

Examiner has argued that in Meister a "Modify Addressees" control allows a user to selectively modify and remove the intended recipients of an e-mail message. A modify addressees control 46 is shown in Figure 2, and discussed at column 3, lines 45 through 49. While modify addressees control 46 allows a user to remove recipients from a message list, modify addressees control 46 does not function similarly to the subject matter set out in claim 1 of the present case.

For example, step (a) of claim 1 sets out that a field of an e-mail message is used to specify addresses to be removed by an electronic mail system from a "To" field. The modify addressees control 46 does not disclose or suggest such a field of an e-mail message.

Likewise, step (a) of claim 1 sets out that the electronic system removes from any addresses specified in the "To" field of the e-mail message any addresses within the field of the e-mail message used to specify addresses to be removed from the "To" field. This is not disclosed or suggested by the modify addressees control 46 disclosed in Meister.

As discussed above, the language of claim 1 specifically requires a *field* of the e-mail message be used to specify addresses to be removed from a "To" field. Examiner has made no attempt to show that an e-mail message shown by Meister includes such a *field*. Rather, Meister only discloses a *control* which allows a user to manually remove addresses from a "To" field of an e-mail message. See Meister at Figure 6 and column 5, lines 17 through 27. Any person of ordinary skill in the art would recognize that the *control* disclosed by Meister

is not a *field* of an e-mail message, as set it in claim 1 of the present case.

Therefore, it is clear that claim 1 is not anticipated by Meister.

Independent Claim 8

Claim 8 sets out a method by which an electronic mail system sends an electronic message. Step (a) sets out that the electronic mail system, in preparation for sending an e-mail message, checks a field of the e-mail message used to specify addresses to be removed by the electronic mail system from all address fields. The electronic system removes from any addresses specified in a "To" field, a "Cc" field and a "Bcc" field of the e-mail message any addresses within the field of the e-mail message used to specify addresses to be removed from all address fields. This is not disclosed or suggested by Meister.

Meister allows a user to manually remove addresses from address fields of an e-mail message. See Meister at Figure 6 and column 5, lines 17 through 27. However, Meister does not disclose or suggest the use of a field of the e-mail message used to specify addresses to be removed from any address field.

Examiner has argued that in Meister a "Modify Addresses" control allows a user to selectively modify and remove the intended recipients of an e-mail message. A modify addressees control 46 is shown in Figure 2, and discussed at column 3, lines 45 through 49. While modify addressees control 46 allows a user to remove recipients from a message list, modify addressees control 46 does not function similarly to the subject matter set out in claim 8 of the present case.

For example, step (a) of claim 8 sets out that a field of an e-mail message is used to specify addresses to be removed by an electronic mail system from all address fields. The modify addressees control 46 does not disclose or suggest such a field of an e-mail message.

Likewise, step (a) of claim 8 sets out that the electronic system removes from any addresses specified in a "To" field, a "Cc" field and a "Bcc" field of the e-mail message any addresses within the field of the e-mail message used to specify addresses to be removed from all address fields. This is not disclosed or suggested by the modify addressees control 46 disclosed in Meister.

As discussed above, the language of claim 8 specifically sets out a *field* of the e-mail message used to specify addresses to be removed by the electronic mail system from all address fields. Examiner has made no attempt to show that an e-mail message shown by Meister includes such a *field*. Rather, Meister only discloses a *control* which allows a user to manually remove addresses from an e-mail message. See Meister at Figure 6 and column 5, lines 17 through 27. Any person of ordinary skill in the art would recognize that the *control* disclosed by Meister is not a *field* of an e-mail message, as set it in claim 8 of the present case. Therefore, it is clear that claim 8 is not anticipated by Meister.

Independent Claim 9

Claim 9 sets out an electronic mail system for generating a message for being sent electronically. The message includes a field used to specify, to the electronic mail system, addresses to be removed from the "To" field in

preparation for sending the message. This is not disclosed or suggested by Meister.

Meister allows a user to manually remove addresses from a "To" field of a message. See Meister at Figure 6 and column 5, lines 17 through 27. However, Meister does not disclose or suggest the use of a field of the message used to specify addresses to be removed from the "To" field.

Examiner has argued that in Meister a "Modify Addresses" control allows a user to selectively modify and remove the intended recipients of an e-mail message. A modify addressees control 46 is shown in Figure 2, and discussed at column 3, lines 45 through 49. While modify addressees control 46 allows a user to remove recipients from a message list, modify addressees control 46 does not function similarly to the subject matter set out in claim 9 of the present case.

Particularly, claim 9 sets out that a field of an e-mail message is used to specify addresses to be removed by an electronic mail system from a "To" field. The modify addressees control 46 does not disclose or suggest such a field of an e-mail message.

As discussed above, the language of claim 9 specifically sets out that a message includes a *field* used to specify, to the electronic mail system, addresses to be removed by the electronic mail system from the "To" field in preparation for sending the message. Examiner has made no attempt to show that an e-mail message shown by Meister includes such a *field*. Rather, Meister only discloses a *control* which allows a user to manually remove addresses from an e-mail message. See Meister at Figure 6 and column 5, lines 17 through 27. Any person

of ordinary skill in the art would recognize that the *control* disclosed by Meister is not a *field* of a message, as set it in claim 9 of the present case. Therefore, it is clear that claim 9 is not anticipated by Meister.

Independent Claim 14

Claim 14 sets out an electronic mail system for generating a message for being sent electronically. The message includes a field used to specify, to the electronic mail system, addresses to be removed from the address fields in preparation for sending the message. This is not disclosed or suggested by Meister.

Meister allows a user to manually remove addresses from all fields of the message. See Meister at Figure 6 and column 5, lines 17 through 27. However, Meister does not disclose or suggest the use of a field of the message used to specify addresses to be removed from the address fields of the message.

Examiner has argued that in Meister a “Modify Addressees” control allows a user to selectively modify and remove the intended recipients of an e-mail message. A modify addressees control 46 is shown in Figure 2, and discussed at column 3, lines 45 through 49. While modify addressees control 46 allows a user to remove recipients from a message list, modify addressees control 46 does not function similarly to the subject matter set out in claim 14 of the present case.

Particularly, claim 14 sets out that a field of an e-mail message is used to specify addresses to be removed by an electronic mail system from address

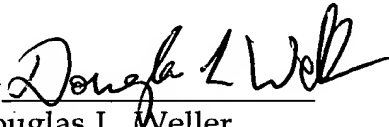
fields of a message. The modify addressees control 46 does not disclose or suggest such a field of a message.

As discussed above, the language of claim 14 specifically sets out that a message includes a *field* used to specify, to the electronic mail system, addresses to be removed by the electronic mail system from the address fields in preparation for sending the message. Examiner has made no attempt to show that an e-mail message shown by Meister includes such a *field*. Rather, Meister only discloses a *control* which allows a user to manually remove addresses from an e-mail message. See Meister at Figure 6 and column 5, lines 17 through 27. Any person of ordinary skill in the art would recognize that the *control* disclosed by Meister is not a *field* of a message, as set it in claim 14 of the present case. Therefore, it is clear that claim 14 is not anticipated by Meister.

Conclusion

Applicant believes the Amendment has placed the present case in condition for allowance and favorable action is respectfully requested.

Respectfully submitted,
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